

REMARKS***Claim Rejections - 35 USC § 102 and 103***Introduction

All claims have been rejected either on the basis of Burg
5 alone under 35 USC § 102, or Burg combined with Veschi under 35
USC § 103.

Burg, US Patent 6,447,247, was filed on August 3, 2000, and
is a continuation of application US 08/884,206 filed June 27,
1997, now US Patent 6,134,319.

10 Veschi, US Patent 6,298,131, was filed on March 30, 1998.

The present application is a continuation of Application
Serial Number 10/065,273 filed September 30, 2002, now U.S.
Patent number 6,687,365 issued February 3, 2004. Said
10/065,273 is in turn a continuation of application serial
15 number 09/683,598 filed January 23, 2002, now abandoned, which
in turn is a continuation of Application Serial Number
09/567,832, filed May 9, 2000, now U.S. Patent number 6,343,125,
issued January 29, 2002, which in turn is a continuation-in-part
of Application Serial Number 09/085,781, filed May 28, 1998, now
20 U.S. Patent number 6,061,443, issued May 9, 2000, which in turn
claims the benefit of expired U.S. Provisional Application No.
60/047,747, filed May 28, 1997. All of the above-referenced
documents have been expressly incorporated by reference into
this application.

Assuming for the sake of argument that everything disclosed by Burg's US 6,447,247 was also disclosed by Burg's priority document 6,134,319, the earliest possible priority date for Burg's disclosures is June 27, 1997. The disclosures of Veschi have a priority date of March 30, 1998. Applicant has a valid priority chain dating all the way back to Provisional Application US 60/047,747, filed May 28, 1997, which predates the earliest possible priorities of both Burg and Veschi.

Because applicant's provisional application predates the earliest possible priority dates of both Burg and Veschi, both of these documents are disqualified as prior art, to the extent that any commensurate disclosures made by Burg on June 27, 1997 or by Veschi on March 30, 1998 had already been made by applicant on May 28, 1997.

In different terms, if it can be shown that all elements of applicant's independent claims were in fact disclosed by applicant's Provisional Application US 60/047,747, filed May 28, 1997, then the disclosures of Burg and Veschi become irrelevant, because applicant's claims are based on disclosures which predate any disclosures that may have been made by Burg and Veschi and this disqualifies Burg and Veschi as prior art.

As described in detail below, the subject matter of applicant's rejected independent claims was in fact first disclosed, fully, in priority application US 60/047,747.

Therefore, Burg and Veschi are both disqualified as prior art, and the final office action should be vacated.

Because no claims are amended with this reply, there cannot possibly be any additional searching necessitated by applicant's amendment. Therefore, this application must now be allowed, or, any advisory action must either reject this disqualification of Burg and Veschi on a solid basis, or, if different references are applied, said advisory action must grant a new, non-final action.

Having overcome all rejections of record by the disqualification of Burg and Veschi as prior art, and given the breadth of prior art already on the record in this case, it is applicant's view that all claims are novel and non-obvious in relation to all qualified prior art of record, and so should be allowed at this time.

Below, we examine in further detail, how all of the independent claims in the present application are indeed fully disclosed by priority application US 60/047,747, thereby disqualifying Burg and Veschi as prior art.

Strictly for examiner's convenience, submitted with this reply is a copy of applicant's priority application US 60/047,747, filed May 28, 1997, which was downloaded as a 49-page PDF file by counsel from the US Patent Office PAIR system. Examiner is of course free to obtain this document directly from

the USPTO files as well.

Disqualification of Burg and Veschi as Prior Art

While this application contains twelve (12) independent
 5 claims, independent claims 10 (method), 59 (apparatus), and 142
 (media) are of substantially identical scope, and differ from
 independent claims 148, 152, 160 only insofar as claims 10, 59,
 and 142 recite a "seven-digit telephone number" while claims
 148, 152, and 160 recite a "destination telephone number." The
 10 same difference applies as between independent claims 108, 125,
 and 146 ("seven-digit telephone number") which are of
 substantially identical scope, and independent claims 156, 158,
 and 164 ("destination telephone number"). Now, we examine how
 the recitations and combination recited in all of these claims
 15 is in fact fully disclosed by applicant's priority application
 US 60/047,747.

Applicant's claim {10, 59, 142}, and [148, 152, 160] all
 recite the following: (Note: we use {10, 59, 142} and [148,
 152, 160] to denote the differences between {"seven-digit"} and
 20 [{"destination"}] in these two claim sets)

"A (method, apparatus, or medium) . . .

comprising:

designating a destination area code;

the user specifying a {seven-digit} [destination]

telephone number; and

causing said call to be signaled using the designated destination area code in combination with the specified {seven-digit} [destination] telephone number, without the user entering said designated destination area code when specifying said {seven-digit} [destination] telephone number, and without analyzing said {seven-digit} [destination] telephone number in relation to telephone numbers previously dialed by the user."

Further, applicant's claims {108, 125, 146} and {156, 158, 164} (using the same denotation as before) read as follows:

"A (method, apparatus, or medium) . . .

comprising:

associating a plurality of area code selectors with a plurality of area codes;

the user selecting one of said area code selectors and thereby selecting its associated area code;

the user specifying a {seven-digit} [destination] telephone number; and

causing said call to be signaled using the selected area code in combination with said specified {seven-digit} [destination] telephone number, without

the user entering said selected area code when specifying said {seven-digit} [destination] telephone number, and without analyzing said {seven-digit} [destination] telephone number in relation to
5 telephone numbers previously dialed by the user."

Now, let us examine applicant's priority application US 60/047,747. Because the page numbering in US 60/047,747 is not sequential, page numbers in the discussion to follow will refer to the page number in the 49-page PDF file transmitted with this
10 reply in #/49 format, and not to any numbers printed on the pages of the actual application.

On page 3/49 in the PDF of US 60/047,747, in point 2), it is stated, with emphasis added:

"If dialing starts with other than a 0 or a 1:

15 All digits are stored in the phone's special 'overlay system memory', and none are passed through until either:

1) 7 digits have been entered + a timing interval has elapsed, in which case, the area code for the
20 parent level of the overlay is output by the phone, followed by the 7 digits that were stored in the 'overlay system memory'.

2) 8 digits have been entered, in which case the phone examines the 8th digit and determines which

level of the overlay the 8th digit is calling for.
 The proper area code is output, followed by the first
 7 digits that were stored in the 'overlay system
 memory'. . . .

5 With these special phones or devices, the area
 codes that the 8th digit determines could be
 programmed by the user, i.e.: 0=818 1=626 2=213
 3=805. The user can put in any coding they want, and
the suffixes don't necessarily have to refer to an
 10 actual overlay level. They might refer to any area
code that the user feels would be convenient to be
able to access with just a single digit at the end of
a 7 digit phone number."

While the disclosure in priority application US 60/047,747
 15 gives a great deal of consideration to overlays, the emphasized
 statement that "the area codes that the 8th digit determines
 could be programmed by the user, i.e.: 0=818 1=626 2=213
 3=805. The user can put in any coding they want, and the
suffixes don't necessarily have to refer to an actual overlay
 20 level" clearly discloses that it is possible to establish
 designated and selected associations with areas codes for
 abbreviated dialing, and that *applicant's disclosure is not tied*
or limited to areas codes which are part of overlay structures
or arrangements.

The specific example "0=818" in the above is important, because throughout the disclosure of US 60/047,747, the 818 area code is taken as an example to be the parent level of an overlay, see, e.g., page 11/49: "parent level of overlay - the original area code (in these examples the 818 area code)." And, because "[t]he user can put in any coding they want," this means that any area code can be designated with the "0" suffix, and not just the parent level of an overlay. In terms of applicant's claims, associating an area code with the "0" suffix (which, as is also disclosed, is a default which allows a call to be signaled after entering only seven digits), fully discloses "designating a destination area code," as recited in claims 10, 59, 142, 148, 152, 160. And, associating area codes with suffixes other than "0," as in the example of "1=626 2=213 3=805," fully discloses "associating a plurality of area code selectors with a plurality of area codes" as recited in claims 108, 125, 146, 156, 158, 164.

Continuing with claims 108, 125, 146, 156, 158, 164, the recitation for "the user selecting one of said area code selectors and thereby selecting its associated area code" is clearly disclosed by the previously-referenced statement that "[when] 8 digits have been entered . . . the phone examines the 8th digit and determines which level of the overlay the 8th digit is calling for. The proper area code is output, followed

by the first 7 digits that were stored in the 'overlay system memory'" The entry of the 8th digit results in this selection of an area code, and as noted above, because "[t]he user can put in any coding they want, and the suffixes don't necessarily have to refer to an actual overlay level," this area code selection is completely general and is not limited or restricted exclusively to area codes contained in overlay structures or arrangements. As is clearly disclosed, these area code selectors "might refer to any area code that the user feels would be convenient to be able to access with just a single digit at the end of a 7 digit phone number."

There are other places in the disclosure where "the user selecting one of said area code selectors and thereby selecting its associated area code" is further underscored. For example: on the top half of page 12/49, it is stated with original emphasis that ". . . the 8th digit is a suffix and acts as an overlay selector. Each area code within the overlay area will be assigned a unique identifier, which will then be used as the '8th digit suffix' or 'overlay selector' in dialing." And again, while "overlay" terminology is used in this discussion, it is made very clear that "[t]he user can put in any coding they want, and the suffixes don't necessarily have to refer to an actual overlay level. They might refer to any area code that the user feels would be convenient to be able to access with

just a single digit at the end of a 7 digit phone number."

Next, we turn to the recitation of "the user specifying a {seven-digit} [destination] telephone number," which appears in all of the independent claims, in either the "seven-digit" or the "destination" form. Clearly, the use of a "seven digit telephone number" is disclosed throughout. But the seven digit telephone number is just one example of a "destination telephone number," as would be apparent to someone of ordinary skill. In addition, applicant discloses throughout a clear understanding that the numbering plans may change in the future, and that telephone numbers might have more digits in the future than they do at present, see for example, page 4/49, point 4. Consequently, the more general view of a "seven digit telephone number" as one example of a "destination telephone number" was clearly understood and in the possession of applicant at the time of the provisional disclosure. Thus, applicant's priority document US 60/047,747 clearly discloses "the user specifying a seven-digit telephone number," as well as "the user specifying a destination telephone number."

Finally, we come to the recitation: "causing said call to be signaled using the [designated destination or selected] area code in combination with the specified {seven-digit} [destination] telephone number, without the user entering said designated destination area code when specifying said {seven-

digit} [destination] telephone number, and without analyzing said {seven-digit} [destination] telephone number in relation to telephone numbers previously dialed by the user."

The earlier-reproduced excerpt from priority document US 60/047,747 makes clear that after "7 digits have been entered + a timing interval has elapsed" (designated destination area code) or after "8 digits have been entered," (selected area code), "the area code for the parent level of the overlay [designated destination area code] is output by the phone, followed by the 7 digits . . . " or "[t]he proper [selected] area code is output, followed by the first 7 digits."

With this disclosure, it is made clear that to anyone of ordinary skill a) that the call will be signaled "using the [designated destination or selected] area code in combination with the specified {seven-digit} [destination] telephone number," b) that this signaling occurs "without the user entering said designated destination area code when specifying said {seven-digit} [destination] telephone number," and c) that this occurs "without analyzing said {seven-digit} [destination] telephone number in relation to telephone numbers previously dialed by the user."

As a consequence, each and every recitation of each and every independent claim is fully disclosed by priority application US 60/047,747, as is the entire combination which is

claimed. Therefore, the later references by Burg and Veschi are disqualified in relation to applicant's independent claims, and these claims should be allowed. Because of this, the rejections of any dependent claims is also overcome.

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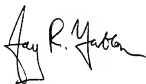
Conclusion

With all rejections of record having been overcome, applicant looks forward to receiving a notice of allowance in the near future.

10 As noted earlier, if this reply does not result in allowance of all claims, applicant's counsel hereby respectfully requests a telephone interview with examiner Thjuan Knowlin Addy, following receipt of this reply, and prior to issuance of any further office action.

15 Finally, as also noted earlier, because no claims are amended, any advisory action which may be issued by examiner will not be necessitated by applicant's amendment. Therefore, any advisory action must either reject this disqualification of references on a solid basis, or, if different references are
20 applied, said advisory action must grant a new, non-final action.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Jay R. Yablon". The signature is fluid and cursive, with the first name "Jay" and last name "Yablon" clearly legible, and "R." in the middle.

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